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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/084,982
Filing Date: March 01, 2002
Appellant(s): MCCARTHY, KEVIN

Phouphanomketh Ditthavong
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 28, 2010 appealing from the Office action mailed March 19, 2009.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-24.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

WISER ET AL	US PATENT 6,868,403 B1
OLRIK	US PreGrant Publication 2004/0092266 A1
SASAKI ET AL	US PreGrant Publication 2002/0077988

(9) Grounds of Rejection

The following ground(s) of PreGrant Publication

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made⁶.

1. **Claims 1-24 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (hereinafter **Wiser**, US 6,868,403 B1) in view of Sasaki et al. (US PreGrant Publication 2002/0077988 A1, hereafter **Sasaki**).

Re Claims 1, 10 & 18, Wiser discloses a method, product and apparatus comprising:

- opening a software application in a terminal (FIG 1; Client System "Web Browser.")
- requesting downloadable content from the open software application (Column 16, lines 30-39, partic. I. 34)
- automatically starting up a network session (Col. 1, ll. 56-59; Col. 3, ll. 10-12-internet; Col. 6, ll. 17-29; Column 16, lines 36-42, partic. I. 40)
- transmitting in said network session a request for downloading said downloadable content for the software application (Col. 3, ll. 6-12; Column 16, ll. 33-47 – clicking the user's "Buy It" button – I. 36),
- downloading said downloadable content (Column 2, lines 13-21; Col. 3, ll. 9-10, 60-65; Col. 5, ll. 4-5, 17-19-delivery in this instance means downloading to the customer's media player from the seller's server; Col. 6, ll. 6-16-the server downloading the content being purchased to the purchaser's media player. The download procedure is described in Col. 18, I. 7 – Col. 19, I. 41);
- enabling a user of the wireless terminal to pre-study said downloaded content (Col. 1, I. 57; Column 2, lines 13-22 (I. 17 – sample audio products, I. 22 – preview music); Col. 3, ll. 9-10, 53-65 – entire song (I. 59) or 'clips' available free fro previewing (ll. 61-62) and descriptive information; Fig. 8 – click here for preview. The enablement detail is implicit).
- effecting payment for the pre-studied downloaded downloadable content for the software application for enabling storing of the pre-studied downloadable content for the software application without further user interaction beyond selecting the pre-studied downloaded downloadable content for storage, wherein effecting the payment is enabled subsequent to an account verification (Col. 4, I. 15 – Col. 5, I. 20. Wiser teaches confirmation of account status prior to the preview, with no further interaction beyond selecting the pre-studied downloadable content for storage since the payment arrangements have already been prearranged through the passport process for a given customer so that payment handling is automatically triggered upon requesting the purchase request, such as at Col.

16, ll. 34 and following. Re. payment after account verification, Wiser does this by first verifying the account and then effecting the payment – Fig. 6, the sequence 602 through 612, and prescreening and preloading of a user's personal information, including a credit card number, prior to a previewing into a utility called a passport. This information is then automatically used to effect payment prior to a download sequence when a user has requested a download for purchase (Col. 4, ll. 15-34, 45-48). This feature in Col. 4, ll. 45-48 also makes moot any suggestion in Sasaki re. the possibility for making use of downloadable content without having received payment. and

- storing of the pre-studied downloaded downloadable content for the software application from which the downloaded downloadable content for the software application was requested in response to effecting of the payment (Col. 5, ll. 9-19; Col. 9, ll. 53-67 - the delivery server stores the downloadable content being sold/purchased while the secure delivery steps take place. In turn, the purchaser's media player eventually stores the delivered content – Col. 6, ll. 1-5, 40-42; Column 10, lines 2-17, partic. ll. 5 & 14).

Wiser does not explicitly disclose

- wherein the terminal is a wireless terminal.
- Opening a software application in a wireless terminal.

However, **Sasaki** discloses the use of a portable wireless device for receiving digital content (Abstract, ll. 2-4). This implies opening a software application in a wireless terminal. Further, Sasaki discloses permitting users who have not as yet purchased the digital content to play back the digital content a limited number of times (page 3, [0033], ll. 6-10, 14-17) as well as an unlimited number of times ([0033]-ll. 10-14. In either case, it is obvious in **Sasaki** that a pre-study enables a user to receive downloadable content in full quality and full length.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to combine the disclosure of Wiser with that of Sasaki in order to use a

wireless application protocol to provide data from a remote server to a mobile station, motivated by a desire to provide a novel digital content distribution scheme that enables digital content owners to reach new potential customers by leveraging the desire of users to share and exchange digital content, while protecting the commercial interests of digital content owners. (Sasaki, p. 1, [0005]-II. 1-5).

Re Claim 2: Wisner in view of Sasaki discloses the claimed method supra and Wisner further discloses wherein the requested downloadable content includes at least a graphic icon (Column 2, line 15 "graphics.").

Re Claim 3: Wisner in view of Sasaki discloses the claimed method supra and Wisner further discloses wherein the network session is a WAP session (Fig. 1)

Re Claim 4: Wisner in view of Sasaki discloses the claimed method supra and Wisner discloses wherein the WAP session is established with a pre-identified content provider (Column 6, lines 17-38; FIG 1; Refs 128-122-112)

Re Claim 5: Wisner in view of Sasaki discloses the claimed method supra and Wisner further discloses wherein the user of the wireless terminal has an account at the pre-identified content provider, and wherein the handling of payment for said downloadable content includes transfer of an amount from said account to the content provider upon approval by the user (Column 17 line 53-Column 18 line 6).

Re Claim 6: Wisner in view of Sasaki discloses the claimed method supra and Wisner further discloses wherein the storing of said downloaded content is enabled once the user has approved said payment (Column 18, lines 7-20).

Re Claim 7: Wisner in view of Sasaki discloses the claimed method supra and Wisner further discloses wherein the WAP session is established with a pre-identified Internet portal hosting at least one content provider (Column 6, lines 17-38; FIG 1; Refs 128-122-112)

Re Claim 8: Wisner in view of Sasaki discloses the claimed method supra and Wisner further discloses wherein the user of the wireless terminal has an account at the pre-identified Internet portal, and wherein the handling of payment for said downloaded

content includes transfer of an amount from said account to the content provider upon approval by the user (Column 17 line 53-Column 18 line 6).

Re Claim 9: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the storing of said downloaded content is enabled once the user has approved said payment (Column 6, lines 40-42).

Re Claims 11-14: Further wireless terminal claims would have been obvious from the previously rejected method claims 1-4 and 15, respectively, and are therefore rejected using the same art and rationale.

Re Claim 15: Wiser in view of Sasaki disclose the claimed method supra. Wiser in view of Sasaki does not explicitly disclose discarding the pre-studied downloaded content if the user does not select to store the pre-studied downloaded content. However, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have known that users of computer storage media often delete or discard stored material in which they have determined that they no longer care to keep that stored information. Such deletions make room for the storage of other information on that storage medium.

Re Claim 17, Wiser discloses a method, wherein automatically starting up the network session further comprises providing a plurality of available downloadable items for selection based on a status of an account of the user (Fig. 3 shows "available items", and the payment capability is checked and payment authorized – Col. 4, ll. 65-66)..

Re Claim 16, Wiser discloses a computer program product wherein an executable portion includes instructions for providing a plurality of available downloadable items for selection based on a status of an account of the user (Fig. 8; Col. 4, ll. 15-37, 58-59-a plurality of media being purchased.).

Re Claim 19: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the requested downloadable content includes at least a graphic icon (Column 2, line 15 "graphics.").

Re Claim 20: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the networks session is a WAP session (Fig. 1).

Re Claim 21: Wiser in view of Sasaki discloses the claimed method supra and Wiser discloses wherein the WAP session is established with a pre-identified content provider (Column 6, lines 17-38; FIG 1; Refs 128-122-112).

Re Claim 22: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the user of the wireless terminal has an account at the pre-identified content provider, and wherein the handling of payment for said downloaded content includes transfer of an amount from said account to the content provider upon approval by the user (Column 17 line 53-Column 18 line 6).

Re Claim 23: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the storing of said downloaded content is enabled once the user has approved said payment (Column 18, lines 7-20).

Re Claim 24: neither Wiser nor Sasaki explicitly disclose the handling of the payment based on a pre-existing agreement associated with the wireless terminal directly with an account. However, Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses a pre-existing account arrangement which electronically recognizes the account (Col. 25, ll. 6-9, 31-32). Sasaki discloses transactions with wireless accounts (see claims 5 and 22) and also discloses pre-paid accounts. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures and suggestions of the art of Wiser and Sasaki with what would have been obvious to the ordinary practitioner in order to handle the payment based on a pre-existing agreement associated with the wireless terminal directly with an account, motivated by a desire to provide a novel digital content distribution scheme that enables digital content owners to reach new potential customers by leveraging the desire of users to share and exchange digital content, while protecting the commercial interests of digital content owners. (Sasaki, p. 1, [0005]-ll. 1-5).

(10) Response to Argument

SUMMARY OF ARGUMENTS:

"CLAIMS 1-24 ARE NOT RENDERED OBVIOUS BY WISER ET AL. AND SASAKI ET AL. BECAUSE NEITHER REFERENCE DISCLOSES OR SUGGESTS A REQUEST FOR, PRE-STUDY OF, AND STORAGE OF, THE SAME DOWNLOADABLE CONTENT, NOR DOES EITHER REFERENCE DISCLOSE OR SUGGEST EFFECTING A PAYMENT ENABLED SUBSEQUENT TO AN ACCOUNT VERIFICATION CONDUCTED RELATIVE TO A USER PRIOR TO THE DOWNLOADING OF THE DOWNLOADABLE CONTENT". (p. 6, ll. 7-14; p. 6, l. 6 – p. 11. l. 7). (Underlining as in Brief).

ARGUMENT A: "NEITHER REFERENCE DISCLOSES OR SUGGESTS A REQUEST FOR, PRE-STUDY OF, AND STORAGE OF, THE SAME DOWNLOADABLE CONTENT,"

ARGUMENT B: "NOR DOES EITHER REFERENCE DISCLOSE OR SUGGEST EFFECTING A PAYMENT ENABLED SUBSEQUENT TO AN ACCOUNT VERIFICATION CONDUCTED RELATIVE TO A USER PRIOR TO THE DOWNLOADING OF THE DOWNLOADABLE CONTENT."

ARGUMENT A: "NEITHER REFERENCE DISCLOSES OR SUGGESTS A REQUEST FOR, PRE-STUDY OF, AND STORAGE OF, THE SAME DOWNLOADABLE CONTENT," (p. 6, ll. 8-10; p. 7, l. 3 – p. 10. l. 15).

Detailed Arguments:

1) CONTENT NOT THE SAME AS PREVIEWED: "The "preview" in *Wiser et al.* is just that, viz., a preview, or a teaser. It is not the content requested or ultimately desired by the user. In fact, the preview video is of much inferior quality and of much more limited duration as compared to the "real," full quality media data (See, e.g., col. 3, lines 60-65). Therefore, in *Wiser et al.*, the "content" that is pre-studied is not the same

"content" that will eventually be downloaded and stored after payment for the content is effected.' (p. 7, l. 19 – p. 8, l. 1).

2) SASAKI TEACHES AWAY: "With regard to the Examiner's assertion, at page 3 of the Final Office Action, that "it is obvious in Sasaki that a pre-study enables a user to receive downloadable content in full quality and full length," *Sasaki et al.* actually teaches away from the instant claimed invention. A reference may be said to "teach away" when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994)." (p. 9, ll. 15-21).

3) ARGUMENTS NOT GERMANE TO THE ISSUE:

- a) In Sasaki, a user may simply copy content from one device to another without payment (p. 9, l. 21 - p. 10, l. 4)
- b) Because in Sasaki meta-data is to be attached to the content ... those skilled in the art would have been discouraged from combining Sasaki with Wiser ... and ... the skilled artisans would have to have used impermissible hindsight gleaned from applicant's disclosure (p. 10, ll. 5-15).

RESPONSE:

1) CONTENT NOT THE SAME AS PREVIEWED:

As documented in the above rejection, Wiser discloses preview options including that of "the entire song" (Col. 3, l. 59) and "descriptive information, such as cover art, lyrics, credits and the like, is also available for previewing"(Col. 3, ll. 64-65). This suggests full disclosure of the requested content. However, Sasaki is also relied upon for two reasons, first, the wireless terminal (not argued) and also preview of the actual content requested either for a limited number of times or for an unlimited number of times (p. 3, [0033]-ll. 6-10, 14-17). This would have been sufficient for the ordinary practitioner to have taken from Sasaki's disclosure in a business method. These disclosures, combined with the knowledge of one of ordinary skill, would have made it obvious to such a practitioner to have seen it as disclosed or suggested for the argued components of "A REQUEST FOR, PRE-STUDY OF, AND STORAGE OF, THE SAME

DOWNLOADABLE CONTENT, NOR DOES EITHER REFERENCE DISCLOSE OR SUGGEST EFFECTING A PAYMENT ENABLED SUBSEQUENT TO AN ACCOUNT VERIFICATION CONDUCTED RELATIVE TO A USER PRIOR TO THE DOWNLOADING OF THE DOWNLOADABLE CONTENT". The disclosure of the storage and prepayment components, not supported with arguments, are documented in the rejection of claim 1 above.

2) SASAKI TEACHES AWAY: Sasaki does not teach away because the ordinary practitioner would not be interested in the disclosures unrelated to the claimed invention(s) since no technical or scientific reason exists for taking anything in a business method for taking anything but the disclosures which solve the specific problem(s) at issue. Otherwise it would be impossible to combine disclosures in business methods on the basis of obviousness.

We have guidance from two court opinions in this matter:

W.L. Gore & Associates v. Garlock, Inc., and in *In re Gurley*, as follows:

(a) W.L. Gore & Associates v. Garlock, Inc. This (case) involves a teaching of "stretching said (unsintered) PTFE at a 10% per second rate to more than five times the original length. A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE, would not have suggested rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly".

Having read this court opinion, the examiner concludes that the relevant aspect of the opinion turned on the court's finding that a technical error had been argued in the justification of an obviousness combination of two teachings. The court finding of a technical distinction in this case could not be clearer. The court found that the combination of the properties of two unrelated polymers was technically incompatible and thus the teachings could not be properly combined. Thus the court followed common sense logic.

(b) The *In re Gurley* opinion offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant, as follows: A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious

composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant's purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

To summarize, these two court opinions demonstrate that the concept of "teaching away" has technical foundations and requirements of a limited, narrow technical nature of a common sense variety.

In this case, It becomes clear that, contrary to Applicant's assertion, trends not cited in the reference as teaching away in a manner relevant to the specific use of the disclosures are moot. There are no disclosures in Sasaki or Wiser which prohibit the modification of Wiser's disclosures from being modified to meet Applicant's limitations such as the previewing of downloadable content. Further, the art of Wiser and Sasaki are analogous. Therefore, since there are no technical and/or scientific barriers to combining the specific disclosures, since we are merely speaking about programmable software steps, the specific disclosures cited by the examiner are combinable without teaching away or using impermissible hindsight.

3) ARGUMENTS NOT GERMANE TO THE ISSUE:

These arguments are negated by the above court opinions.

ARGUMENT B: "NOR DOES EITHER REFERENCE DISCLOSE OR SUGGEST EFFECTING A PAYMENT ENABLED SUBSEQUENT TO AN ACCOUNT VERIFICATION CONDUCTED RELATIVE TO A USER PRIOR TO THE DOWNLOADING OF THE DOWNLOADABLE CONTENT." (p. 6. II. 10-14; p. 10. I. 16 – p. 11, I. 7).

Specific Argument:

"Contrary to this claim feature, *Wiser et al.* does not confirm account status until after preview content is requested and delivered (See, e.g., Figs 8 and 9a)." (p. 10, I. 22 – p. 11, I. 1).

RESPONSE:

As documented in the above rejection of claim 1, Col. 4, l. 15 – Col. 5, l. 20 in Wisner teaches confirmation of account status prior to the preview, with no further interaction beyond selecting the pre-studied downloadable content for storage since the payment arrangements have already been prearranged through the passport process for a given customer so that payment handling is automatically triggered upon requesting the purchase request, such as at Col. 16, ll. 34 and following. Re. payment after account verification, Wisner does this by first verifying the account and then effecting the payment – Fig. 6, the sequence 602 through 612, and prescreening and preloading of a user's personal information, including a credit card number, prior to a previewing into a utility called a passport. This information is then automatically used to effect payment prior to a download sequence when a user has requested a download for purchase (Col. 4, ll. 15-34, 45-48). This feature in Col. 4, ll. 45-48 also makes moot any suggestion in Sasaki re. the possibility for making use of downloadable content without having received payment.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Siegfried E. Chencinski/

Examiner, Art Unit 3695

Conferees:

Charles Kyle/ck/, SPE

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Vincent Millin /vm/

Appeals Conference Specialist